

EV550716769

PTO/SB/21 (09-04)

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TRANSMITTAL  
FORM

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Total Number of Pages in This Submission

Application Number

10/823,886

Filing Date

April 13, 2004

First Named Inventor

Brad L. Sherwood

Art Unit

3711

Examiner Name

Stephen Luther Blau

Attorney Docket Number

UI1-013

## ENCLOSURES (Check all that apply)



Fee Transmittal Form



Fee Attached



Amendment/Reply



After Final



Affidavits/declaration(s)



Extension of Time Request



Express Abandonment Request



Information Disclosure Statement



Certified Copy of Priority Document(s)

Reply to Missing Parts/  
Incomplete ApplicationReply to Missing Parts  
under 37 CFR 1.52 or 1.53

Drawing(s)



Licensing-related Papers



Petition

Petition to Convert to a  
Provisional Application

Power of Attorney, Revocation



Change of Correspondence Address



Terminal Disclaimer



Request for Refund



CD, Number of CD(s) \_\_\_\_\_



Landscape Table on CD



After Allowance Communication to TC

Appeal Communication to Board  
of Appeals and InterferencesAppeal Communication to TC  
(Appeal Notice, Brief, Reply Brief)

Proprietary Information



Status Letter

Other Enclosure(s) (please identify  
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## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

Wells St. John P.S.

Signature

Printed name

Mark S. Matkin

Date

6-2-05

Reg. No.

32,268

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I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

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Date

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/17 (12-04v2)

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Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

**FEETRANSMITTAL**

JUN 02 2005

For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 500.00

**Complete if Known**

Application Number	10/823,886
Filing Date	April 13, 2004
First Named Inventor	Brad L. Sherwood
Examiner Name	Stephen Luther Blau
Art Unit	3711
Attorney Docket No.	UI1-013

**METHOD OF PAYMENT (check all that apply)**☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_☒ Deposit Account Deposit Account Number: 23-0925 Deposit Account Name: Wells St. John P.S.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

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**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	N/A
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES****Fee Description**

Each claim over 20 (including Reissues)

Fee (\$)	Small Entity Fee (\$)
50	25
200	100
360	180

Each independent claim over 3 (including Reissues)

Multiple dependent claims

<b>Total Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
- 20 or HP =	x	=	N/A

HP = highest number of total claims paid for, if greater than 20.

<b>Indep. Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
- 3 or HP =	x	=	N/A

HP = highest number of independent claims paid for, if greater than 3.

<b>Multiple Dependent Claims</b>	
<b>Fee (\$)</b> <b>Fee Paid (\$)</b>	
	N/A

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

<b>Total Sheets</b>	<b>Extra Sheets</b>	<b>Number of each additional 50 or fraction thereof</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
- 100 =	/ 50 =	(round up to a whole number) x	=	N/A


**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Appeal Brief

<b>Fees Paid (\$)</b>
N/A
500.00

**SUBMITTED BY**

Signature 	Registration No. 32,268 (Attorney/Agent)	Telephone (509) 624-4276
Name (Print/Type) Mark S. Matkin	Date 6-2-05	

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. .... 10/823,886  
 Filing Date ..... April 13, 2004  
 Inventor..... Brad L. Sherwood  
 Assignee..... U.I.G., Inc.  
 Group Art Unit..... 3711  
 Examiner ..... Stephen Luther Blau  
 Attorney's Docket No. .... UI1-013  
 Title..... Correlated Set of Individually Numbered Golf Club Irons

**BRIEF OF APPELLANT**

To: Mail Stop Appeal Brief - Patents  
 Commissioner of Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

From: Mark S. Matkin (Tel. 509-624-4276; Fax 509-838-3424)  
 Wells St. John P.S.  
 601 W. First Avenue, Suite 1300  
 Spokane, WA 99201-3828

Appellant appeals from the December 7, 2004 final rejection of claims 1  
 and 69. A check is included in the amount of \$500.00 in payment of the fees  
 required under 37 CFR 41.20(b)(2).

06/07/2005 MAHRED1 00000059 10823886

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## TABLE OF CONTENTS

I.	REAL PARTY IN INTEREST.....	3
II.	RELATED APPEALS AND INTERFERENCES.....	3
III.	STATUS OF CLAIMS.....	3
IV.	STATUS OF AMENDMENTS.....	4
V.	SUMMARY OF CLAIMED SUBJECT MATTER.....	4
VI.	GROUND OF REJECTION TO BE REVIEWED ON APPEAL.....	5
VII.	ARGUMENT.....	6
VIII.	CONCLUSION.....	10
IX.	CLAIMS APPENDIX.....	11

## **I. REAL PARTY IN INTEREST.**

The real party in interest of this application is U.I.G., Inc. as evidenced by the full assignment of the pending application to U.I.G., Inc. recorded at reel 012831, frames 0546-0550 on April 17, 2002 in the Assignment Branch of the Patent and Trademark Office.

## **II. RELATED APPEALS AND INTERFERENCES.**

Appellant's undersigned legal representative and the assignee of the pending application are not aware of any appeals or interferences that will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

## **III. STATUS OF CLAIMS.**

Claims 1 and 69 are pending in the application, with claims 2-68 having been previously canceled. Claims 1 and 69 stand finally rejected and are being appealed.

#### **IV. STATUS OF AMENDMENTS.**

Appellants filed an After-Final Amendment on January 4, 2005 to correct recently discovered typographical errors in the specification. A January 25, 2005 Advisory Action to such filing states that the proposed amendment will be entered for the purposes of appeal.

#### **V. SUMMARY OF CLAIMED SUBJECT MATTER.**

A concise explanation of the invention defined in the claims that are the subject of the present appeal follows.

The invention includes a correlated set of individually numbered golf club irons having heads progressing from a high numbered head (shorter hitting club) to a low numbered head (longer hitting club). Referring to Figs. 1-5, preferred embodiments of individual heads have a front striking face 50, a sole 54, a toe 56, and a heel 58 (p.6, Ins.9,10.). The front striking faces 50 of heads within the set individually have some planar area defining a progressively decreasing loft angle A (Fig. 3) in going from the high numbered head to the low numbered head. The planar area has a top and a bottom. Individual front striking faces 50 have a series of grooves 55 (in Figs. 1; 5 and 6. Groove 75 in Fig. 7; groove 75b in Fig. 8; groove 75c in Fig. 9; and groove 75d in Fig. 10.) of a common cross sectional shape from the top to the bottom of the planar area of a given head.

For at least two chosen pairs of heads within the set, the grooves are configured to provide decreasing golf ball spin in going from the lower numbered head to the higher numbered head in the pair if the golf ball were hit by the faces by identical impacts at the same loft angle (p.11, Ins.3-7). However, the grooves are required to be of different cross sectional shape in the pair. Any groove configuration in accordance with the above is contemplated (p.8, Ins.1-14.).

In one preferred implementation and as recited in claim 69, the individual grooves have a base (base 13 in Figs. 5 and 6, and bases 22 in Figs. 7-9 and 11) and opposing sidewalls (sidewalls 14 in Figs. 5 and 6, and sidewalls 24 in Figs. 7-9 and 11) which diverge from the base and extend outwardly in the direction of the front striking face (p.8, Ins.4-6 and p.13, Ins.16-18). At least one of an opposing sidewall and the base comprises at least one protrusion (protrusion 15 in Figs. 5, and protrusions 28 in Figs. 7-11) which extends into the groove.

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.**

Are claims 1 and 69 unpatentable under 35 USC 103(a) over U.S. Patent No. 4,754,971 to Kobayashi in view of U.S. Patent No. 5,766,087 to Kawamatsu?

## VII. ARGUMENT.

Claim 1 in the parent application was initially rejected under 35 USC 102(b) over Kobayashi. Kobayashi discloses varying friction within a set of golf clubs either by varying the coefficient of friction of the golf club flat planar hitting face (Fig. 1), or by varying the number of grooves across the golf club face (Fig. 2). However, the only teaching from Kobayashi is that the cross sectional shape of the grooves is the same in all of the clubs within the Kobayashi sets (see for example Fig. 2e). Applicant successfully overcame such rejection by amending claim 1 to additionally recite that "the grooves [are] of different cross sectional shape in the pair".

The Examiner relies on Kawamatsu in combination with Kobayashi as rendering claim 1 unpatentable. However, the Examiner has not considered both references in their entirety, including disclosures therein that teach away from the claims, and as is required by MPEP §2141.02. Further, where an Examiner asserts that there is a suggestion or motivation to modify a prior art reference, the proposed modification cannot render the prior art unsatisfactory for its intended purpose. (MPEP §2143).

Applicant's independent claim 1 includes the limitations that the grooves are "configured to provide decreasing golf ball spin in going from the lower numbered head to the higher numbered head in the pair". Applicant's independent claim 1 also includes the limitation of "the grooves being of different cross sectional shape in the pair". The Examiner acknowledges that Kobayashi does not disclose the latter limitation, and relies upon the Kawamatsu



patent. However, modifying the Kobayashi club sets in accordance with Kawamatsu would render either prior art reference unsatisfactory for its respective intended purpose.

Specifically, Kobayashi is principally directed to decreasing golf spin in going from the lower numbered head to a higher numbered head in a set. On the other hand, Kawamatsu is directed to the exact opposite. Therefore, it teaches away from Applicant's claim 1 and, if combined with Kobayashi, would render it unsatisfactory for its intended purpose of decreasing golf ball spin in going from the lower numbered head to a higher numbered head. Alternately or additionally considered, if Kawamatsu was modified in accordance with the Kobayashi teaching, Kawamatsu would be rendered unsatisfactory for its intended purpose of increasing ball spin in going from the lower numbered head to a higher numbered head. The cited references are directed toward opposite primary intended purposes in the context of Applicant's claim 1. Therefore, the Examiner's conclusion of a suggestion of modifying either reference to combine with the teaching of the other renders each prior art reference unsatisfactory for its respective intended purposes in the context of Applicant's claim 1, and the Examiner's position should therefore be reversed in accordance with MPEP §2143.

The Examiner asserts that he has weighed the power of each reference to suggest solutions to one of ordinary skill in the art considering the degree to which one reference might accurately discredit the other. However, such cannot be considered in a vacuum, and must be considered in the context of Applicant's claim 1. Specifically, Applicant's independent claim 1 is directed to and requires

that the grooves “provide decreasing golf ball spin in going from the lower numbered head to the higher numbered head in the pair”. If this phrase were not in Applicant’s independent claim 1, the Examiner’s position might have merit. However since this phrase is in Applicant’s claim 1, and considering claim 1 in its entirety, the “solutions” suggested to one of ordinary skill in the art must be considered in the light of claim 1. To allow otherwise enables an Examiner to merely pick and choose from portions of prior art references that support their position and ignore, and not be held accountable for, those that do not support their position. Clearly here, the Examiner has only taken a portion of the respective teachings of the two references that support his position, picking and choosing from the references, and not considering them in their entirety, including that which teaches away from the very combination which the Examiner makes. Pursuant to the mandates of the MPEP, examination requires consideration of the whole reference, not only the portions in support of the Examiner’s position.

Applicant’s independent claim 1 does not specifically recite anything with respect to varying “coefficient of friction” regardless of whether such occurs in the practice of the claim 1 invention. Indeed, the words “friction” and “coefficient” appear nowhere in Applicant’s application independent of what effect might be happening to a coefficient of friction in Applicant’s inventive sets. Yet, claim 1 is directed to the grooves being configured to provide decreasing golf ball spin in going from the lower numbered head to the higher numbered head in the pair. Accordingly with respect to what Applicant does claim (namely, the stated decreasing golf ball spin relationship), the references teach the

opposite with respect to each other, and modification of the teaching of either reference renders the respective prior art unsatisfactory for its intended purpose regarding the change of golf ball spin within a golf club set. Applying either reference to the teaching of the other in the context of Applicant's claim 1 clearly renders the other inoperable for its intended purpose of either increasing or decreasing golf spin in going from the lower numbered head to the higher numbered head in the pair. For the reasons argued above, the Examiner has not accurately weighed the power of each reference with respect to how each completely discredits the other in the context of Applicant's independent claim 1. Therefore, claim 1 should be allowed, and action to that end is requested.

The undersigned acknowledges the premises in MPEP §2144 that the rationale/reason to modify a particular reference, or the rationale/reason to combine references, need not be the same as an Applicant's reason/rationale of the invention. However, those premises do not enable an Examiner to ignore or get around the requirements of MPEP §2143 that the proposed modification cannot render an applied reference unsatisfactory/inoperable for its intended purpose when considered in the context of an Applicant's claim. The various sections of the MPEP mandates must be considered in harmony with one another, not separately and independently. As the proposed modification renders either prior art reference unsatisfactory for their respective teachings concerning increasing/decreasing golf ball spin, *prima facie* obviousness has not been established in the rejection of claim 1 over these references. It is respectfully requested that the rejection be reversed, and that claim 1 be allowed.


Claim 69 should be allowed as depending from an allowable base claim and for its own recited features which are neither shown nor suggested in the relied upon art. The Examiner asserts that a Kobayashi groove has a base from which a protrusion extends into the groove. However to do so, the Examiner concludes that two identical grooves in Kobayashi are really a single groove, and then perceives/fabricates a base for the new single groove that is simply not shown in the drawings nor otherwise disclosed by the reference. Accordingly, claim 69 recites something that is not shown in either or the cited references, and should therefore be allowed on its own merits. Reversal of this rejection is requested.

## VIII. CONCLUSION.

In view of the foregoing, reversal of the final rejections of claims 1 and 69 is respectfully requested. Allowance of such claims is also requested.

Respectfully submitted,

Dated: 6-3-05

By:   
Mark S. Matkin  
Reg. No. 32,268

## **IX. CLAIMS APPENDIX.**

1. (Previously Presented): A correlated set of individually numbered golf club irons having heads progressing from a high numbered head to a low numbered head; individual heads having a front striking face, a sole, a toe, and a heel; the front striking faces of heads within the set individually having a planar area defining a progressively decreasing loft angle in going from the high numbered head to the low numbered head, the planar area having a top and a bottom, individual front striking faces having a series of grooves of a common cross sectional shape from the top to the bottom; for at least two chosen pairs of heads within the set, the grooves being configured to provide decreasing golf ball spin in going from the lower numbered head to the higher numbered head in the pair if the golf ball were hit by the faces by identical impacts at the same loft angle, the grooves being of different cross sectional shape in the pair.

Claims 2-68 (Canceled).

69. (Previously Presented): The correlated set of individually numbered golf club irons of claim 1 wherein the individual grooves have a base and opposing sidewalls which diverge from the base and extend outwardly in the direction of the front striking face; at least one of an opposing sidewall and the base comprising at least one protrusion which extends into the groove.